

REMARKS

Reconsideration of this application is requested.

The claims pending in the application are claims 1-13, 15-20, 22 and 23. Of these, claims 1-5 are drawn to processes for printing an image; claims 6-13 are directed to tris-azo compounds; claims 15-18 are drawn to compositions while claims 19, 20, 22 and 23 are specifically concerned with uses of the compositions or tris-azo compounds.

The Examiner has objected to claims 1, 5, 6, 7-9 and 12 as "being of improper dependent form for failing to further limit the subject matter of a previous claim". The Examiner then goes on to say that the claims should be canceled or amended to place the same in proper dependent form or rewritten in independent form. The Examiner then states that the word "optionally" is non-limiting and "therefore, the limitations that are optional are not considered as part limiting".

The Examiner is respectfully requested to reconsider and/or clarify her above-stated objection to claims 1, 5, 6, 7-9 and 12. For one thing, claims 1 and 6 are themselves presented in independent form. Hence, these claims cannot be objected to as improper dependent claims. Claim 5 depends from claim 1 but clearly is narrowing in scope with respect to claim 1. For example, claim 1 defines A as alkenyl, homocyclic or heterocyclic while claim 5 defines A as optionally substituted pyridyl (or other specifically recited heterocyclic). There is, therefore, clearly a difference in scope between claims 1 and 5, no matter what weight the Examiner places on the applicant's reference to "optionally". Claim 5 is even further limited with respect to claim 1 in that the substitutions which are optional in A and L¹ are specifically recited (see last nine lines of claim 5). Other narrowing differences exist in claim 5 relative to claim 1. Note the difference in the scope of the L¹ and L² definitions. Clearly, in the circumstances, claim 5 further limits the scope of claim 1.

The same is true for claims 7-9 and 12, each of which is clearly narrower in scope than the claim from which they depend (claim 6). Even if the Examiner gives no significance to the reference to "optionally", the language of claims 7-9 and 12 manifestly is narrower in scope than that of claim 6.

It is not clear from the Examiner's comments if she has objections to use of the term "optionally" other than to view this as non-limiting which is, in a sense, true as the language is, of course, intended to be readable on the case where the recited groups are either unsubstituted or substituted. It is, in any case, noted that claims 5 and 12 specifically recite what the optional substituents may be (see last nine lines of

claims 5 and 12). Other claims also indicate what the optional substituents may be. See, for example, proviso (iii) for L¹ and L² of claim 6 and claim 10.

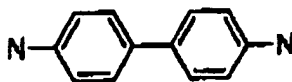
Notwithstanding the forgoing, the applicants' claims have been amended by deleting the references to "optionally" except for those claims where the optional substitution is specifically recited. See, particularly, claims 5 and 12, last nine lines thereof for all substitutions; and claim 6. In view of the foregoing, the Examiner is requested to reconsider and withdraw the objections to claims 1, 5, 6, 7-9 and 12 as set out on page 2, 2nd ¶ of the action.

The Examiner has rejected claims 6-8 under Section 102(b) as anticipated by Sparks (U.S. 2,370,500). Reconsideration of the rejection is requested as the applicant's compounds of claims 6-8 are not disclosed by Sparks.

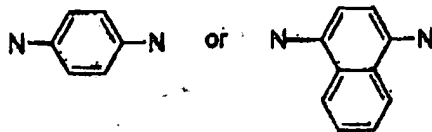
It is noted initially that, in the Examiner's presentation of applicants' claim 6, provisos (ii) and (iv) are erroneously recited as being the same. This is not correct. In applicant's claim 6, proviso (ii) states that:

L¹ and L² are each independently optionally substituted phenylene or naphthalene"

As indicated, the applicant's compounds of claim 6 require that L¹ and L² are each independently phenylene or naphthylene. However, in the Sparks compounds, L² (using the applicant's designation) is biphenyl, i.e.



This is not phenylene or naphthylene as required in proviso (ii) of applicant's claim 6, i.e.



Thus, claim 6 clearly differentiates from Sparks.

Claims 7 and 8 depend from claim 6 and, therefore, distinguish over Sparks for the reasons noted with respect to claim 6. Furthermore, claims 7 and 8 require that A is selected from a list of heterocyclic groups (claim 7) or a pyridyl group (claim 8). In Sparks, the A group (continuing to use the applicant's terminology) is a substituted phenyl group, i.e. a homocyclic group, whereas, as noted, A in the applicant's compounds of claims 7 and 8 is a heterocyclic. Clearly, therefore, claims 7 and 8 are not anticipated by Sparks.

In view of the foregoing, the Examiner is requested to withdraw the Section 102(b) rejection of claims 6-8 on the basis of the Sparks disclosure.

The applicant does not understand the Examiner's parenthetical comment ("optionally does not mean that A has to be substituted by any of the listed formulas") in the case of claim 7 and the generally similar parenthetical language with respect to claim 8 (lines 2-5, page 4 of the action). The term "optionally" is certainly used by the applicant to indicate that the heterocyclics referenced in claims 7 and 8 are present and may be substituted (i.e. "optionally substituted") or unsubstituted. This is clearly the intent of the claim language. If, on the other hand, the Examiner considered the reference to "optionally substituted heterocyclic" meant that the heterocyclic group was itself optional and that the claims could be read as though no substituent was present, the applicant would take issue with this. Clearly the reference to an optionally substituted ring means the ring is present but is optionally substituted. There is no other reasonable way to read the claim language.

The Examiner is respectfully requested to reconsider the Section 103(a) rejection of claims 1, 5, 9-12 and 16-18 as unpatentable over Sparks in view of Ciba (GB 741578). The rejected claims define subject matter which is not obvious from the Examiner's references.

Applicant's claim 1 is drawn to a process for printing an image on a substrate using a composition including a tris-azo compound as defined. There is no suggestion in Sparks that the dyes disclosed therein could be used to print an image on a substrate. Sparks is concerned with azo dyes for dyeing cellulosic or similar fibers. It is not in any sense obvious from Sparks that the Sparks dyes or the applicant's tris-azo compounds could be used for printing an image on a substrate.

Process claim 5, which depends from claim 1, is even further removed from Sparks in that claim 5 requires that the tris-azo compounds which are used for printing have one of the recited heterocyclic groups as the A substituent. The A substituent in Sparks is a phenyl group. This would not in any way suggest the use of the applicant's compounds of claim 5 where A is heterocyclic.

Claims 9-12 are claims to compounds per se and depend from claim 6. Claims 9-12 distinguish patentably from Sparks for the reasons noted above with reference to claim 6. Furthermore, there is nothing in Sparks suggestive of tris-azo compounds having the L¹ or L² substituents called for in claims 9-12.

Claims 16-18 also depend from claim 6 and define patentably over Sparks for the reasons noted above. Furthermore, there is nothing in Sparks to suggest the compositional features of claims 16-18.

Ciba does not fill in the substantive differences noted above with respect to Sparks. There is really no reason to combine the references as the Examiner has done but, even if the references are considered together, the invention defined in claims 1, 5, 9-12 and 16-18 is not reached. In particular, there is nothing in either of the references to suggest that the applicant's tris-azo compounds as defined in the rejected claims could be useful for printing images on a surface or for providing compositions for this purpose.

The Examiner's Section 103(a) rejection as stated at page 4, 3rd full ¶ of the action makes no reference to claim 15. This claim is, however, discussed by the Examiner at page 6, 1st full ¶ of the action. The applicant respectfully submits that claim 15, which depends from claim 1 defines subject matter which is patentable over Sparks and Ciba for the reasons noted in connection with claim 1. There is nothing in either of the Examiner's references suggesting the use of the features of claim 15 to provide a composition as defined. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the Section 103(a) rejection of claims 1, 5, 9-12 and 16-18 based on Sparks and Ciba GB 741578.

The Examiner is also requested to reconsider the Section 103(a) rejection of claims 2-4, 19, 20, 22 and 23 as unpatentable over Sparks considered with Ciba (GB 741578) and Murcia (U.S. 2001/0012027). These references do not make the invention defined in the rejected claims obvious.

Claims 2-4 depend from claim 1 and should be allowable over the Examiner's references for the reasons noted above, it being noted that Murcia does not fill in the deficiencies of the other references.

With regard to the Examiner's Section 103(a) rejections, it is also noted that Sparks is an old document (published 1940) which relates to a completely different technical field, namely, the dyeing of cellulosic and similar fibers (page 1, lines 3-4). Sparks suggests absolutely nothing about the usefulness of its compounds in the much later technical application of ink-jet printing. The Ciba reference, as explained in the applicant's previous response, teaches the use of completely different compounds, namely, metal complexes of azo compounds. There is consequently no motivation to combine compounds from a 1940 document (Sparks) relating to non-metal complexed compounds for dyeing of fibers with a later document (Ciba) relating to completely different metal complexed compounds for use in a completely different technical field.

The Examiner's further reference, Murcia et al. (U.S. 2001/0012027A), as explained in the response to the last Office Action, relates purely to printer hardware

and is totally silent as to which compounds or compositions may be useful in ink-jet printing. Thus, Murcia et al. add nothing at all to the teaching of Sparks or Ciba regarding the non-obviousness of the presently claimed compounds or use of these compounds for ink-jet printing.

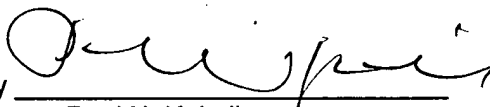
Claims 19, 20, 22 and 23 depend from claim 15, 6 or 1, respectively, and should be patentable over the art for the reasons noted with respect to claims 1, 6 and 15.

The allowability of claim 13, if made independent, has been noted. However, the dependence of claim 13 (on claim 6) has been maintained as claim 6 is thought to be allowable for the reasons noted.

For all of the reasons noted above, the applicant submits that his claims are in acceptable form and define novel and otherwise patentable subject matter. Accordingly, favorable reconsideration with allowance is requested.

Respectfully submitted,

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